

REMARKS

This response is being filed in response to the non-final Office Action dated March 26, 2008. By this Response, claims 1, 2, 5, 6, 15-17, 19 and 20 are cancelled without prejudice and claims 3, 4, 7, 8, 13, 14, 18 and 20 are amended. No new matter is added. Claims 3, 4, 7-14, 18 and 20 are active for examination.

The rejections and objection in connection with claims 1, 2, 5, 6, 15-17 and 19 are moot

Claims 1, 2, 5, 6, 15-17 and 19 are canceled without prejudice. According, the rejections and objection in connection with the cancelled claims are moot.

The obviousness rejection related to claims 3, 4, 7-14, 18 and 20 are overcome

(1) Claims 3, 7, 9, 10, 11, 12, 18 and 20

Claims 3, 7, 9, 11, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell et al. (U.S. Patent No. 6,535,590) in view of Chatterjee et al. (Pub No.: US 2007-0248221) and Schein et al. (Pub No.: US 2003/0208758). The obviousness rejection is overcome because the claim limitations are not obvious to one of ordinary skill in the art even after considering all the cited documents.

Claim 3 describes a communication terminal, such as a cellular phone that when an incoming communication arrives from a communication partner in the course of a video reproduction carried out by the terminal, informs the communication partner of an end time of the video reproduction.

Tidwell only describes a set top box that offers functions allowing a user to use telephone functions or managing call functions, such as forwarding calls, rejecting calls, etc., via a television, such as by entering the symbol *60 to the set top box. Chatterjee describes a device providing a function to delay a call, in which the caller is verbally notified by a facilitator device

that the user is busy and that the user will call back at a later time specified by the facilitator. Tidwell and Chatterjee, if viewed together, at most inspires a set top box as described in Tidwell to provide a delay call function, as described in Chatterjee, that provides a verbal prompt to any caller that the user will call back at a future time. The combination of Tidwell and Chatterjee does not inspire one of ordinary skills to come up with a claimed communication terminal that when an incoming communication arrives from a communication partner in the course of a video reproduction carried out by the terminal, informs the communication partner of an end time of the video reproduction.

Another cited document, Schein cannot be effectively combined with Tidwell and Chatterjee under 35 USC 103 because combining Schein with Tidwell and Chatterjee does not involve the use of known technique to improve similar devices in the same way, the combination of prior art elements according to known methods to yield predictable results, or the application of a known technique to a known device ready for improvement to yield predictable result.

In Schein, a method is proposed to control the recording of TV programs using multiple VCRs 34 and 36. Computer software is provided to turn off the record functions when program end time occurs. Apparently, Schein relates to controlling multiple VCRs and is not a comparable device to telephone communication systems discussed in Tidwell and Chatterjee. One of ordinary skill in the art could not have combined specific elements in Schein to improve Tidwell and Chatterjee to meet the claim limitations **without teachings from Applicant's own disclosure**.

Furthermore, without teachings from Applicant's own disclosure indicating that an end time of a program should be conveyed to a caller, the only **predictable result** that one of ordinary skilled in the art would have come up with from the combination of Schein with

Tidwell and Chatterjee is a set top box that provides telephone functions through a television (according to Tidwell), a delay call function that provides a verbal prompt to any caller that the user will call back at a future time (according to Chatterjee) and a function to control the recording of multiple VCRs according to end time of programs (according to Schein). This combination, apparently, does not meet all claim limitations.

Moreover, according to Tidwell, when a telephone call arrives, an audio tone is output or a visual indicator is displayed on a screen. See Figs. 4 and 5 of Tidwell. In this manner, Tidwell never teaches not to disturb a user from watching a TV program as described in this application. Tidwell specifically describes that “they merely have to select an icon” and “all that is necessary is that a particular icon be selected.” See column 7, lines 25 and 30. Accordingly, Tidwell relies on the assumption of requiring a user to select one of the icons even when the user is watching a TV program. Therefore, the teaching in Tidwell teaches away from meeting a device constructed according to the claims which is designed to avoid interruptions to the user.

Since Tidwell, Chatterjee and Schein cannot support a prima facie case of obviousness, the obviousness rejection of claim 3 is overcome.

Independent claims 7, 18 and 20 include descriptions substantially similar to those of claim 3. Accordingly, claims 7, 18 and 20 are patentable for at least the same reasons as for claim 3.

Claims 9 and 11 depend on claims 3 and 7, respectively. Therefore, claims 9 and 11 are patentable by virtue of their dependencies.

Claims 10 and 12 depend on claims 3 and 7, respectively, and are rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of Chatterjee, Schein and further in view of Buettgenbach.

Buettgenbach is cited for its purported discussion related to automatic generation of email notification. The teaching does not alleviate the deficiencies of Tidwell, Chatterjee and Schein, as discussed earlier relative to claim 3. Therefore, claims 10 and 12 are patentable for at least the same reasons as for claim 3.

(2) Claims 4, 8, 13 and 14

Claims 4, 8, 13 and 14 Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of Chatterjee, Schein and further in view of Willame et al. (Pub. No.: US 2006/0179462). The obviousness rejection is overcome because the cited documents cannot support a prima facie case of obviousness.

Claim 4 describes a communication terminal that includes a setting device allowing a user to set an incoming-reporting condition indicating whether a video reproduction takes precedence of an operation to report an incoming communication or said operation to report an incoming communication takes precedence of said video reproduction. In the event of an incoming communication from a communication partner in the course of the video reproduction carried out by said video reproduction device: the communication partner is informed of the end time of said video reproduction if said incoming-reporting condition is set to indicate that said video reproduction takes precedence of an operation to report said incoming communication; and said incoming communication is reported if said incoming-reporting condition is set to indicate that an operation to report said incoming communication takes precedence of said video reproduction.

As discussed earlier relative to claim 3, the combination of Tidwell, Chatterjee and Schein cannot support a prima facie case of obviousness related to the feature of informing a communication partner of an end time of a video reproduction when an incoming

communication arrives from the communication partner in the course of the video reproduction, as described in claim 4. Another document, William, is cited by the Office Action for its purported discussion related to resolving time conflicts when recording two programs around the same time. One program is given higher program than the other based on a priority list. William does not teach or suggest informing a communication partner of an end time of a video reproduction when an incoming communication arrives from the communication partner in the course of the video reproduction, as described in claim 4. Accordingly, the obviousness rejection of claim 4 based on Tidwell, Chatterjee, Schein and Willame is untenable and should be withdrawn. Favorable reconsideration of claim 4 is respectfully requested.

Claim 8 is patentable over Tidwell, Chatterjee, Schein and Willame for reasons similar to claim 4.

Claims 13 and 14 depend on claim 4. Therefore, claims 13 and 14 are patentable over the cited art by virtue of their dependencies as well as based on their own merits.

Incidentally, Applicants note that the Office Action asserts that "Tidwell discloses...allowing the user to activate a number of options including priority calling, in which the user can rank the importance of phone numbers so that some incoming calls will cause the system to alert the user and some will not." See page 4, lines 1-5 of the Office Action. However, upon a detailed review of Tidwell, nowhere does Tidwell describe that the user can rank the importance of phone numbers so that some incoming calls will cause the system to alert the user and some will not, as asserted by the Office action. Accordingly, this assertion is not supported by the cited document.

CONCLUSION

For the reasons given above, Applicants believe that this application is in condition for allowance, and requests that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representative listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Wei-Chen Nicholas Chen
Registration No. 56,665

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000
Facsimile: 202.756.8087
Date: June 26, 2008
WDC99 1554174-2.062758.0075

**Please recognize our Customer No. 20277
as our correspondence address.**